



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/962,094 10/31/97 BILLING-MEDEL P 5995.US.P1

ABBOTT LABORATORIES
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ABBOTT PARK IL 60064-3500

HM22/0706

EXAMINER

ARTHUR, L

ART UNIT	PAPER NUMBER
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1655

DATE MAILED:

07/06/00

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
08/962,094

Applicant(s)

Billings-Medel et al.

Examiner

Lisa Athur

Group Art Unit
1655



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on May 8, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
 - ☐ they raise the issue of new matter. (See note below).
 - ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: The amendment of the claims to recite "50% identity" has broadened that claim and raised new issues under 35 U.S.C. 112, first paragraph which require further consideration and search.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attachment

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: none

Claims rejected: 1-13, 15, 16, 33, 35, and 38-48

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

Art Unit: 1655

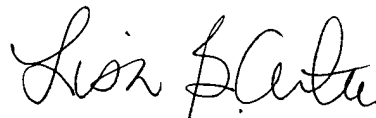
ATTACHMENT TO ADVISORY ACTION

The arguments are not convincing because applicant's have presented no evidence that the detecting the presence of BS106 mRNA in a tissue other than breast is indicative of breast cancer. The fact that PSA and mammaglobin are detectable in blood and are indicative of cancer is not evidence that detection of every tissue specific transcript in a different tissue is correlated to a cancer. While it is known that cancer cells are often detectable in peripheral blood, the skilled artisan could not then conclude that all the cellular nucleic acid is correlated to cancer. Clearly, most of the nucleic acid in the cancer cell is not cancer specific. Consequently, more evidence is required to establish that detection of BS106 in a non-breast tissue is indicative of breast cancer. Therefore the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Arthur whose telephone number is (703) 308-3988. The examiner can normally be reached on Monday from 7:00 am to 3:30 pm and on Tuesday -Wednesday from 7:00 am to 1:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1096.



LISA B. ARTHUR
PRIMARY EXAMINER
GROUP 1800 1600

July 5, 2000